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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,896	12/12/2000	Carlos Pinzon	05725.0806-00	5467

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EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,896

Applicant(s)

PINZON ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 318-336 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 318-336 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 30 May 2006 is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 335 and 336 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The compositions of "ethylenediamine/stearyl dimmer tallate copolymer" recited in claim 335 and "ethylenediamine/stearyl dimmer dilinoleate copolymer" recited in claim 336 and critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The Specification does not teach the specific monomers included to produce either copolymer. Nothing is disclosed to show the tallate or dilinoleate esters.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 318-336 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-102 of copending Application No. 09/733,897. Although the conflicting claims are not identical, they are not patentably distinct from each other because the constituents, as recited and claimed herein, may be included in the compositions recited in the claims. Note claims 27-29, in particular. The composition must be produced before it is employed in a utility, as recited.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 318-336 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 336-367 of copending Application No. 09/733,898. Although the conflicting claims are not identical, they are not patentably distinct from each other because the constituents, as recited and claimed herein, may be included in the compositions recited in the claims. Note claims 337, 338, 341, 347, in particular.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 318-336 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-126 of copending Application No. 10/129,377. Although the conflicting claims are not identical, they are not patentably distinct from each other because the constituents, as recited and claimed herein, may be included in the compositions recited in the claims. Note claim 28, for the polyamide, claim 84, for the inclusion of gums, which broadly embraces alkylated guar, as recited in the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 318-336 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 and 41-44 of copending Application No. 10/198,931. Although the conflicting claims are not identical, they are not patentably distinct from each other because the constituents, as recited and claimed herein, may be included in the compositions recited in the claims. Note claims 1, 37 and 43-48, for the polyamides recited in claims 319, 335 and 336 and for the inclusion of polysaccharide resins, which broadly embraces alkylated guar and alkyl celluloses, as recited in the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 318-334 and 336 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-124

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of copending Application No. 10/203,254. Although the conflicting claims are not identical, they are not patentably distinct from each other because the constituents, as recited and claimed herein, may be included in the compositions recited in the claims. Note claims 28-37 and 57-70, for the polyamides recited in claims 319 and 336 and claims 88, 89 and 99 for the inclusion of polysaccharide resins, which broadly embraces alkylated guar and alkyl celluloses, as recited in the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 318-334 and 336 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-124 of copending Application No. 10/203,254. Although the conflicting claims are not identical, they are not patentably distinct from each other because the constituents, as recited and claimed herein, may be included in the compositions recited in the claims. Note claims 300, 320 and 321, for the polyamides recited in claims 319 and 336 and claims 303 and 312 for the inclusion of the recited and claimed "alkylated guar gums and alkyl celluloses."

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 318-325, 328-332 and 334 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19

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of U.S. Patent No. 6,761,881, newly cited to Bara. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition of the cosmetic claimed embraces the components recited and claimed herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 318-334 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrari (USPN 6,402,408), Ross et al (USPN 5,500,209) or Pavlin et al (USPN 5,783,657) taken with Palinczar (USPN 4,699,779) Mondet (USPN 6,180,123) or Arnaud et al (USPN 5,961,998).

The references to Ferrari (USPN 6,402,408), Ross et al (USPN 5,500,209) and Pavlin et al (USPN 5,783,657) all teach the conventionality of producing a composition comprising a liquid fatty phase which comprises a polyamide polymer and an oil phase as herein claimed.

The reference to Ferrari (USPN 6,402,408) teaches the identical components for the liquid fatty phase as recited in claims 320-326 and 330-334 at column 6 (lines 10) to column 7 (line 23). Note column 3 (lines 37 et seq) for the polyamides employed, including that recited in claim 319. Note column 7 (lines 11-23) for the addition of thickening agents and liposoluble polymers.

The reference to Ross et al (USPN 5,500,209) teaches the identical components for the liquid fatty phase as recited in claims 320-326 and 330-334 at column 15 (lines 48-55) and column 16 (lines 23-54). Note column 6 (lines 15-33 and 52-63), the paragraph bridging column 7 to column 8 and column 14 (lines 46-63) for the polyamides employed. Note column 9 (lines 15-18) for the use of thickening agents and column 11 (lines 11-38) for the polysaccharides and derivatives thereof.

The reference to Pavlin et al (USPN 5,783,657) teaches the identical components for the liquid fatty phase as recited in claims 320-326 and 330-334 at column 15 (lines 48-55) and column 16 (lines 23-54). Note column 3 (lines 31-47), column 3 (line 56) to column 4 (line 48) and column 14 (lines 46-63) for the polyamides employed, including that recited in claim 319. The reference teaches the addition of other constituents at column 14 (lines 28-67) and column 17 (lines 24-33)

The references to Palinczar (USPN 4,699,779), Mondet (USPN 6,180,123) and Arnaud et al (USPN 5,961,998), all teach the conventionality of using alkylated cellulose and gums as suitable thickening agents for compositions that may comprise an oily phase, as herein claimed. These derivatives are notoriously known in the art as thickening agents and coating agents and are liposoluble polymers. Note in Palinczar (USPN 4,699,779) at column 6 (lines 6-45), column 10 (lines 33-55) and the paragraph bridging column 10 to column 11. The reference to Mondet (USPN 6,180,123) shows the use of alkylated guar at column 12 (lines 13-20) for use in an oil phase identical to that included herein. Note column 7 (line 55) to column 8 (line 59) for an oil phase identical to that recite in instant claims 320-326 and 330-334. The patent to Arnaud et al

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(USPN 5,961,998) shows the use of alkyl ethers of guar at column 2 (lines 52 et seq) for use in an oil phase, as recited and herein claimed. Note column 5 (line 26) to column 6 (line 13) for the composition as recited in claims 322, 323, 325 and 327-334.

The primary references teach the essential constituents of a polyamide resin with an oil phase. The subsequent employment of the polysaccharides of either secondary reference in the compositions as set out by the primary references would be prima facie obvious to an artisan of ordinary skill. The constituents all appear to be conventional and known. No unexpected results have been shown on the record with regard to the inclusion of either constituent.

Response to Arguments

With regard to the rejection of claims 335 and 336 under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling, the Specification fails to teach the specific monomers to produce either copolymer or the tallate or dilinoleate esters. Applicants assert that the "Specification clearly discloses Uniclear®, and that Uniclear® polymers are 'mixtures of copolymers derived from monomers of (i) C₃₆ diacids and (ii) ethylenediamine,'" and references the "(i)ntant Application at page 12, ¶ 4. Uniclear® is the tradename for ethylenediamine/stearyl dimer tallate copolymer and ethylenediamine/stearyl dimer dilinoleate copolymer, as claimed in claim 335 and 336. See Exhibit 1 of Applicants' April 19, 2005, Second Substitute Amendment, CTFA pages 657-58. Thus, contrary to the Office's assertion, the specification does teach the specific monomers by alternatively referencing them by their tradename (sic)."

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At page 12, ¶ 4, the Specification teaches that "(t)hese polymers ...**may be mixtures of copolymers** derived from monomers of (i) C₃₆ diacids and (ii) ethylenediamine," without specifically identifying the monomers employed. The broad terms employed are not deemed sufficient even as Applicants urge that "specification does teach the specific monomers by alternatively referencing them by their tradename," which cannot be determinative of enablement. Note MPEP 608.01(v) under the section titled "I. Trademarks," reproduced below.

The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931).

Since the product identified by a trademark may change at the whim of the manufacturer, applicants' remarks concerning the use thereof to determine the enablement of the specific compounds is not well-founded.

Further, note the reference to Blin et al (US 2005/0276767) which at paragraph [0205] shows these compositions, Uniclear 80 and 100 to be "a mixture." Applicants cannot, and have not shown reasonable motivation as to why they believe they are permitted, pick a constituent from a combination of resins, as shown for Uniclear 80 and 100, and assert the use thereof.

With regard to the several rejections of the claims under the judicially-created doctrine of obviousness-type double patenting, no timely filed Terminal Disclaimers have been presented to the Office to overcome these rejections.

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With regard the rejection of claims 318-334 under 35 U.S.C. 103(a) as being unpatentable over Ferrari (USPN 6,402,408), Ross et al (USPN 5,500,209) or Pavlin et al (USPN 5,783,657) taken with Palinczar (USPN 4,699,779) Mondet (USPN 6,180,123) or Arnaud et al (USPN 5,961,998), applicants assert that there is no motivation to combine the teachings of these references. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Contrary to applicants' assertions, the references cited teach the conventionality of the constituents and their uses in compositions analogous to that recited and claimed herein. A skilled artisan would have an expectation of success to arrive at the instantly claimed invention in view of the teachings of the references taken together as pointed out in the rejection. Nothing has been shown by applicants that would indicate otherwise, or that they have achieved any surprising or unexpected results. Applicants have characterized each of the references in comparison to the instantly claimed invention as though the requirements of 35 USC 102 were in place. Applicants are reminded that the rejection has been made under 35 USC 103, and not 35 USC 102. Applicants have ignored the broad teachings of the references to allege that "even though individual components of the invention may be found separately in the

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references of record, these separate disclosures do not defeat the patentability of the composition as a whole. These components are shown by the analogous references to be used together for their art-recognized uses.

The fact that all constituents are shown to be conventional and used in their art-recognized capacities would present motivation sufficient to combine the teachings. The references to Palinczar, Mondet and Arnaud et al all show the methylcellulose and alkylated guar gums as conventional thickening agents. The primary references to Ferrari, Ross et al and Pavlin et al all employ thickening agents. What more is necessary to establish a prima facie case of obviousness? The Examiner is at a loss to understand why applicants insist upon applying the standards of 35 USC 102 to the rejection, since this rejection was made under 35 USC 103. If the thickeners of methylcellulose and alkylated guar gum were disclosed in the primary references, the rejection may well have been made under 35 USC 102, but that is not the case here. Applicants argue voluminously but fail to be convincing since they have not overcome the reasons, as set out above, for the rejection.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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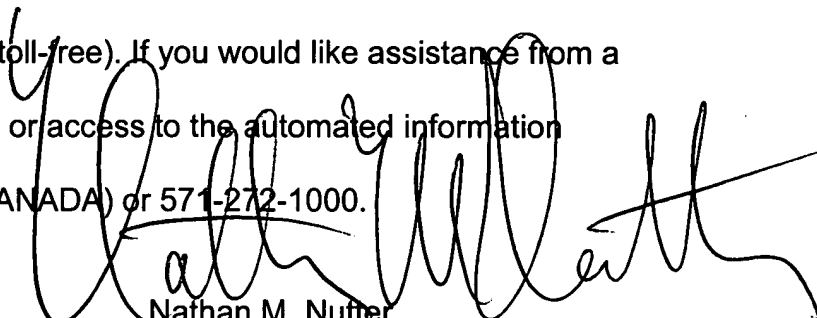
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

11 July 2006